

REMARKS/ARGUMENTS

Claims 1-49 are pending in the instant application. Claims 7, 12-31, 34-38, 40-47 are directed to non-elected claims and are withdrawn from consideration. Claims 1-6, 8-11, 33, 34, and 39 are under examination and are rejected in the office action. Claims 1-4 have been amended by Applicants. Applicants also added new claims 48 and 49. The amendments and the newly presented claims do not constitute new matter in contravention of 35 U.S.C. §132.

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments. Applicants respectfully submit that the amendments are fairly based on the specification and respectfully request their entry.

Specification-Objections

Applicants have amended the Specification above to delete the embedded hyperlink and/or other forms of browser-executable code, in accordance with the Examiner's suggestions. Applicants respectfully request that the objections to the Specification be withdrawn.

35 U.S.C. § 101 REJECTION OF CLAIMS 1-6, 8-11, 32, 33, & 39

Claims 1-6, 8-11, 32, 33 and 39 are rejected under 35 USC § 101 for, in the Examiner's view, lacking patentable utility. More specifically, the Examiner asserts that the claimed invention is not supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility. Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants first note that the utility requirement of § 101 is met either if the claimed subject matter has a "well-established" utility, or if a substantial, specific, and credible utility is disclosed in the specification.

An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (*e.g.*, properties or applications of a product or process), and (2) the utility is specific, substantial, and credible.

Utility Examination Guidelines, 66 Fed. Reg. 1092, 1098 (Jan. 5, 2001). For example, "some uses can be immediately inferred from a recital of certain properties." *In re Folkers*, 344 F.2d 970, 974 (C.C.P.A. 1965) (explicitly undisturbed by *Brenner v. Manson*, 383 U.S. 519, 535 n.23 (1966) and *In re Kirk*, 376 F.2d 936, 949 (C.C.P.A. 1967) (Rich, J., dissenting)). In particular, when "newly discovered compounds [that] belong to a class of compounds, the members of which have become well recognized as useful for a particular purpose because of a particular property, the only reasonable conclusion is that the new compounds, also possessing that property, are similarly useful." *Folkers* at 975, *see also* MPEP 2107.02.

In the instant application, claimed subject matter comprises nucleic acid sequences encoding a human patched like protein, with a Patched domain, a Sterol-sensing domain and twelve transmembrane regions (page 139, lines 3-30; FIG. 1). The Sterol-sensing domain and the twelve transmembrane regions overlay the Patched domain. The Patched proteins, at the time the application was filed, were well known to be part of the sonic hedgehog-patched-gli pathway, mutations of any member of which causes hereditary disorders or cancer. It is also known that proteins with a sterol-sensing domain likely participate in cholesterol-related cellular functions (BACKGROUND OF THE INVENTION, page 2, line 6 to page 4, line 12, for details and references). Expression analysis revealed that the nucleic acid sequence of the current invention is strongly expressed in testis, but at very low levels in other tissues (Table 1; FIG. 5). This resembles strikingly the expression pattern of Desert Hedgehog and a homolog of patched, PTCH2 (Carpenter *et al.*, *Proc. Natl. Acad. Sci. USA* 95:13630-13634 (1998)). It was well established, before the application was filed, that one can use an oncogene or tumor suppresser gene in cancer diagnosis, prognosis, and in the development of therapeutics and treatment. Also well know is the technique for prenatal diagnosis by mutation analysis of disease-causing genes. The nucleotide sequences of these genes can be used as a reference to compare to gene sequences from patients or healthy individuals for mutation analysis, cancer diagnosis and prognosis. The sequences can be used as substrates on microarrays for expression analysis in cancer patients or patients with developmental disorders. The sequences can also be used as antisense inhibitors of the

over-expressed genes in patients. The sequences can be used to produce proteins, antibodies or fusion proteins useful for the diagnosis and development of therapeutics as well. In addition, the nucleic acid sequences can be used to develop primers and probes, the primers can be used in PCR amplification of fragments of the gene, while the probes can be used for expression analysis.

Because the claimed nucleic acid sequences of the instant application encodes a patched like protein, containing a patched domain and with specific expression in testis, Applicants respectfully submit the claimed nucleotide sequences of the instant application belong to a class of compounds, the members of which have well-established utility. Applicants respectfully submit that the claimed nucleotide sequences, which are also capable of these particular purposes, are similarly useful. According to the Federal Circuit, “[t]he threshold of utility is not high: An invention is 'useful' under section 101 if it is capable of providing some identifiable benefit.” *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366 (Fed. Cir. 1999) (emphasis added).

35 U.S.C. § 112 REJECTION OF CLAIMS 1-6, 8-11, 32, 33, & 39
FOR LACK OF ENABLEMENT

Claims 1 – 6, 8 – 11, 32, 33 and 39 stand rejected under 35 U.S.C. § 112, ¶ 1 for lack of enablement. According to the Examiner, since the claimed invention is not supported by a specific or substantial utility or a well-established utility, the disclosure also fails to enable one skilled in the art to make and use the invention.

Applicants respectfully traverse the rejection. Applicants respectfully submit that because the claims indeed display a well-established utility for the reasons advanced above, the derivative rejection for non-enablement would be in error if reasserted against these claims. Applicants respectfully request therefore that the rejection be withdrawn.

35 U.S.C. § 112 REJECTION OF CLAIMS 1-6, 8-11, 32, 33, & 39
FOR LACK OF WRITTEN DESCRIPTION

Claims 1 – 6, 8 - 11, 32, 33 and 39 are further rejected under 35 USC § 112, first paragraph as containing subject matter that is not adequately described in the specification. Specifically, the Examiner objects to what he views as a lack of description sufficient to convey to one skilled in the art that the inventor had possession of the invention, at the time of filing, except for SEQ ID NO:1. Applicants respectfully traverse this rejection.

Solely for sake of expedition, however, and without admitting to the adequacy of the Examiner's *prima facie* case of unpatentability, Applicants have amended claims 1 - 4 to more clearly set forth the claimed invention. Applicants have deleted the phrase “with conservative amino acid substitutions”, added the word “complete” in between “the” and “complement” in claims 1 - 3, deleted “at least 17 contiguous nucleotides of SEQ ID NO:4,...” in claim 4, and amended claim 1 to recite specific function. Applicants respectfully submit that in view of the above amendments to claims 1 - 4, as supported by the original claims and specification, one of ordinary skill in the art can clearly determine

that Applicants were in possession of the invention at the time of filing. Therefore, reconsideration is respectfully requested.

Applicants respectfully submit that the genera now claimed are fully supported by the specification and that the rejection should be withdrawn.

35 U.S.C. § 102(b) REJECTIONS

Claims 1-6 and 8-11 are rejected under 35 U.S.C. § 102(b) as been clearly anticipated by Carpenter et al. 1998 (hereinafter "Carpenter"). Specifically, the Examiner asserts that the cited reference discloses a nucleic acid (AF091501) that encodes multi-transmembrane protein patched, and AF091501 (Position 57-61) is complementary to SEQ ID NO:1 (position 6 – 10) of this application. Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants respectfully point out that Carpenter teaches the nucleic acid sequence of PTCH2, a homolog of PTCH, which is a receptor for Sonic Hedgehog (Shh), a secreted molecule implicated in the formation of embryonic structures and in tumorigenesis. The current invention is directed to the nucleotide sequence encoding a Patched like protein expressed mainly in testis (Summary of the invention, pages 4-5; Figures 3 and 5). The nucleic acid sequence of the current invention is of very limited homology to the nucleic acid sequence of PTCH2 (AF091501). In addition, Applicants have amended claims 1 – 4 as shown and described above. These amendments (and

newly presented claims 48 and 49) clearly distinguish the current invention from the Carpenter reference. Applicants submit that the current invention cannot be anticipated by Carpenter as set forth above. Thus, Applicants respectfully request that the above rejections be withdrawn.

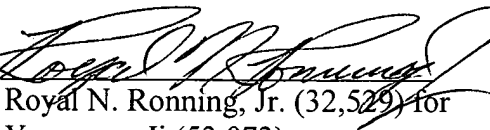
Claims 1, 32, 33 and 39 are rejected under 35 U.S.C. § 102(b) as been clearly anticipated by Scott et al. (US 6,027,882; hereinafter "Scott"). Specifically, the Examiner asserts that the Scott discloses a nucleic acid (SEQ ID NO:3) that encodes a twelve transmembrane domain (PTC) patch like protein, having diagnostic uses. The Examiner asserts that the sequence of SEQ ID NO:3 (position 2-4) is complementary to the instant SEQ ID NO:1 (position 14-16). Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants respectfully point out that while Scott teaches the nucleic acid sequence encoding a patch like protein, it encodes a different protein as compared to the protein encoded by the nucleic acid sequence of the present invention. The nucleic acid sequence of the current invention is of very limited homology to the nucleic acid sequence of the Scott protein. In addition, Applicants have amended claims 1 – 4 as shown and described above. These amendments (and newly presented claims 48 and 49) clearly distinguish the current invention from the Scott reference. Applicants submit that the current invention cannot be anticipated by Scott as set forth above. Thus, Applicants respectfully request that the above rejections be withdrawn.

Early and favorable action is earnestly solicited.

Respectfully submitted,


AMERSHAM BIOSCIENCES CORP

By 
Royal N. Ronning, Jr. (32,529) for
Yonggang Ji (53,073)
Agent for Applicants

Amersham Biosciences Corp
800 Centennial Avenue
P. O. Box 1327
Piscataway, New Jersey 08855-1327

Tel: (732) 980-2875
Fax: (732) 457-8463

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on January 26, 2004.

Signature: 

Name: _____

Melissa Leck